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Reply to Office Action of December 24, 2003

### REMARKS

The invention provides an apparatus for the storage of disk-shaped data storage media. The apparatus includes a flat housing (10) and a coupling member (14). The housing (10) has a slot opening (16) via which a reception space for the data storage medium is accessible, wherein the coupling member (14) can be inserted into the housing (10) via the slot opening (16) and is releasably latched to the flat housing (10) in the inserted state, thereby substantially enclosing the medium within the reception space. The coupling member (14) releasably connects the housing (10) to a carrier (42).

### 35 U.S.C. §102(b)

In the Office Action dated December 24, 2003, Claim 16 was rejected under 35 U.S.C. §102(b) as being anticipated by Schweinsberg (EP 0 289 698 A2). Schweinsberg discloses a coupling member (60) fixedly secured to a conventional CD/DVD tray (12). The coupling member (60) is pivotally coupled to closeable halves (14, 16) of a conventional CD/DVD jewel box for pivotal movement of the tray (12) between the halves (14, 16).

Claim 16 has been amended to define the coupling member as being insertable into a slot opening of a flat housing and releasably connected to the flat housing for substantially enclosing data storage media within a reception space. The coupling member now includes an outer portion having at least one coupling element that allows the coupling member to be releasably connected to a carrier. It is appreciated that a claim is anticipated under § 102 only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Schweinsberg does not disclose a coupling member that is insertable into the slot of and releasably connected to the housing to substantially enclose the

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data storage media within the reception space. Schweinsberg also does not disclose a coupling member that is releasably connected to a carrier. Applicant respectfully submits that the Schweinsberg reference does not include each and every limitation as set forth in Claim 16, as currently amended. Applicant respectfully submits that amended Claim 16 now defines over Schweinsberg, and requests that the anticipation rejection by Schweinsberg under § 102(b) be withdrawn.

**35 U.S.C. §103(a)**

Claim 1 was rejected under 35 U.S.C. §103(a) as being unpatentable over Gloger (US 5,676,246) in view of Schweinsberg. Gloger discloses a flat housing (10) having a slot opening (20) for receiving data storage media therein. Schweinsberg discloses a coupling member (60) fixedly secured to a conventional CD/DVD tray (12). The coupling member (60) is pivotally coupled to closeable halves (14, 16) of a conventional CD/DVD jewel box for pivotal movement of the tray (12) between the halves (14, 16).

Claim 1 has been amended to define the coupling member as being releasably latchable to the flat housing to hold the data storage medium within the reception space. Additionally, Claim 1 has been amended to include the elements of claim 10. Specifically, the coupling member now includes the outer portion having at least one coupling element via which the coupling member can be connected to the carrier.

It is well appreciated that some teaching, suggestion or motivation must be found in the prior art reference(s) which would motivate one skilled in the art to modify the reference to arrive at the claimed invention. This teaching, suggestion or motivation cannot be gleaned from the claimed invention itself. That is, the reference must be viewed without the benefit of

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impermissible hindsight vision afforded by the claimed invention. *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986).

Applicant urges that neither Gloger nor Schweinsberg teaches or suggests a combination the housing of Gloger with the coupling member of Schweinsberg to make the storage apparatus of the present invention. Indeed, Applicant agrees with Examiner that Gloger lacks and does not expressly disclose a coupling member. Neither reference teaches the coupling member that is releasably latchable to the flat housing for enclosing the data storage medium within the reception space. Gloger discloses the use of a set of bristles, strips of felt, or hinged flap (column 3, lines 28-35) to prevent the entry of dust into the housing. Gloger does not, however, anticipate or provide any motivation for incorporating a coupling member, as disclosed in Schweinsberg, for enclosing the data storage medium within the reception space and for connecting the housing to a carrier. Applicant, therefore, respectfully submits that Claim 1 is not unpatentable over Gloger (US 5,676,246) in view of Schweinsberg, since neither reference teaches, suggests or provides motivation to make the present invention as defined in Claim 1.

Claims 2, 8-10, 12 and 15 were also rejected under 35 U.S.C. §103(a) as being unpatentable over Gloger in view of Schweinsberg. Claims 2, 8-10, 12 and 15 depend from Claim 1 and, as such, include every element provided in Claim 1. Applicant, therefore, respectfully submits that Claims 2, 8, 9, 12 and 15 are not unpatentable over Gloger (US 5,676,246) in view of Schweinsberg. Applicant respectfully requests that the §103(a) rejections of Claims 1, 2, 8, 9, 12 and 15 be withdrawn. Claim 10 is now canceled because the limitations contained therein are now included in amended claim 1.

Claims 3-7 were rejected under 35 U.S.C. §103(a) as being unpatentable over Gloger-Schweinsberg as applied to claim 1, and further in view of Saito (U.S. 4,476,978). Saito

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discloses a disc case having a jacket 11 and a lid 12. The jacket 11 includes an opening for receiving a disc therein. A lid 12 is insertable into the opening for enclosing the disc within the jacket 11. The lid 12 does not, however, include an outer portion having at least one coupling element via which the coupling member can be connected to the carrier, as provided by the invention. Indeed, none of the prior art references of record disclose, teach or suggest a coupling member which can be inserted into the slot opening of a flat housing; is releasably connected to the flat housing; and which has an outer portion via which the coupling member can be releasably coupled to a carrier. Applicant, therefore, respectfully submits that Claims 3-7 are not unpatentable over Gloger-Schweinsberg in view of Saito. Applicant respectfully requests that the §103(a) rejections of Claims 3-7 be withdrawn.

#### 35 U.S.C. §112

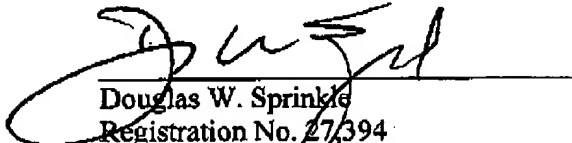
Claims 1-10, 12, 15 and 16 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1-9, 12 15 and 16 have been amended to address the indefiniteness and antecedent basis issues as presented by Examiner. Applicant respectfully submits that all claims have been amended to overcome the §112 rejection and requests that the rejections under §112 be withdrawn.

#### CONCLUSION

Applicant respectfully submits that all of the claims in the instant application patentably define Applicant's invention over the prior art references of record and are, therefore, allowable. Accordingly, reconsideration of the above rejections and advancement of the present case to issue is respectfully requested.

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Respectfully submitted,

  
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Douglas W. Sprinkle  
Registration No. 27,394  
Gifford, Krass, Groh, Sprinkle,  
Anderson & Citkowski, P.C.  
280 N. Old Woodward Ave., Suite 400  
Birmingham, MI 48009-5394  
(248) 647-6000

Attorney for Applicant

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**CERTIFICATE OF FACSIMILE**

I hereby certify that this correspondence is being sent to the United States Patent Office via facsimile (703-872-9306) on May 13, 2004.

  
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Lynn J. Hill